UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,954	11/26/2003	Heeren Pathak	VIGN1540-1	9409

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EXAMINER
FERNANDEZ RIVAS, OMAR F

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/723,954	PATHAK ET AL.
	Examiner	**Art Unit**	
	Omar F. Fernández Rivas	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 November 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-25</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-25</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>26 November 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/7/2004</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-25 are pending on this application.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer system must set forth a practical application of judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application.

For a claimed invention to be statutory the claimed invention must produce a useful, concrete, and tangible result. The Courts have found that subject matter that is not a <u>practical application or use</u> of an idea, a law of nature or a natural phenomenon is not patentable. See, e.g., *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507 (1874) ("idea of itself is not patentable, but a new device by which it may be made practically useful is"); *Warmerman*, 33 F.3d at 1360, 31 USPQ2d at 1759.

For a claimed invention to be statutory under 35 U.S.C. 101, the claims must have the FINAL RESULT (not the steps) produce a useful (specific, substantial, AND credible), concrete (substantially repeatable/ non-unpredictable), AND tangible (real world/ non-abstract) result.

If the specification discloses a practical application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

In the present case, claim 1 describes a software product that applies a set of rules to a set of data. The claims provide the steps for performing this task. The rules are applied to the data, but the result of this process is kept within the computer and nothing is done with it. This is considered to be manipulation of data inside of a computer, which is an abstract idea (not tangible). The result of the process must be provided to an outside device to make the device useful or somehow presented to the user in a way that it can be perceived and used.

Claims 2-7 provide the steps to perform the process of claim 1, but fail to solve the tangibility issue of claim 1 and are therefore rejected.

Claims 8-25 describe the same subject matter as claims 1-7 and have the same deficiencies. Claims 8-25 are therefore rejected on the same basis as claims 1-7.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Croy

(US Patent Application #09/832,323, referred to as **Croy**).

Claims 1 and 9

Croy anticipates a software product for dynamically applying rules (**Croy**: Abstract),

comprising a set of computer instructions stored on a computer readable medium, executable by

a computer processor to:

associate a rule with a rule condition (**Croy**: Abstract; page 1, par 11, L 1-17; page 6,

Claim 1, L11-15; Examiner's Note(EN): storing rules based on the elements required to complete

the transaction is associating rules to a condition);

receive a user interaction based on a first set of content (**Croy**: page 1, par 11, L 1-17;

page 1, par 5; page 5, par 53, L27-35; page 6, Claim 1, L3-21; EN: presenting a display or

submission form to a user to input data is a first set of content);

determine if the rule is applicable based on a state of the rule condition (**Croy**: page 4, par

44, L 1-10; page 5, par 53, L28-38, Fig. 10); and

if the rule is determined to be applicable, apply the rule to the user interaction (**Croy**:

page 5, par 53, L14-38, Fig. 10).

Claims 2 and 10

Croy anticipates determining if the rule is applicable based on the state of the rule

condition, further comprises determining if the rule is applicable based on the

value of metadata (**Croy**: page 3, par 41, L 1-11; page 4, par 44, L1-10; page 5, par 50; page 5,

par 53, L20-22; EN: the different data submitted by the user and the data needed by the rules is

metadata) .

Claims 3 and 11

Croy anticipates the metadata is one of user metadata, content metadata, rule metadata or system metadata (**Croy**: page 4, par 44, L1-10; EN: content metadata).

Claims 4, 12 and 24

Croy anticipates the rule condition represents a metric and wherein computer instructions are further executable to determine if the rule is applicable by comparing the metric to a goal (**Croy**: page 4, par 44, L 1-10; page 5, par 53, L27-38, Fig. 10; EN: the metric is the format of the data, the goal is that the data submitted complies with the required format).

Claims 5 and 13

Croy anticipates the rule condition is represented by an object accessible by the set of computer instructions (**Croy**: page 4, par 43; page 4 par 44 L 1-6; page 5, par 53, L20-22, Figs. 2-4 and 6; EN: the rules are stored in a database which is accessible by computer instructions).

Claims 6 and 14

Croy anticipates the computer instructions are further executable to make a call for the object to access the rule condition (**Croy**: page 5, par 53, L20-38, Fig. 10; EN: accessing the database).

Claims 7, 16 and 18

Croy anticipates the computer instructions are further executable to generate a second set of content responsive to the user interaction if the rule applies and generate a third set of content, which is distinct from the second set of content, if the rule does not apply (**Croy**: page 5, par 53, L20-38; Fig. 10; if the validation is positive (rules apply) submit data and execute the transaction, if it is negative (rule does not apply) return an error message).

Claims 8 and 25

Croy anticipates the computer instructions are further executable to update the state of

the rule condition (**Croy**: page 2, par 32, L9-11; Figs. 3-4; EN: refreshing the rules is updating).

Claims 15 and 22

Croy anticipates applying the rule to generate a second set of content (**Croy**:

page 5, par 53, L20-26).

Claim 17

Croy anticipates associate a rule with metadata (**Croy**: Abstract; page 1, par 11, L 1-

17; page 5, par 53, L27-38; page 6, Claim 1, L11-15; EN: associate the rules to the metadata

input by the user); receive a set of user interaction data based on a particular user's

interaction with a first set of content **Croy**: page 1, par 11, L 1-17; page 5, par 53, L27-35;

page 6, Claim 1, L3-21); determine if the rule is applicable to the set of user interaction data

based on the value of the metadata (**Croy**: page 3, par 41, L 1-11; page 4, par 44, L1-10;

page 5, par 50; page 5, par 53, L20-22); and if the rule applies, apply the rule to the set of user

interaction data (**Croy**: page 5, par 53, L14-38, Fig. 10).

Claim 19

Croy anticipates the first set of content, second set of content and third set of content

comprise web site content (**Croy**: page 1, par 10; page 5, par 53, L26-38; Figs. 5, 7-8

and 10).

Claim 20

Croy anticipates the computer instructions are further executable to apply the rule to

the set of user interaction data by: comparing a trigger in the user interaction data to criteria

in the rule (**Croy**: page 4, par 44, L 1-10; page 5, par 53, L27-38, Fig. 10; EN: the trigger is the

format in the data input by the user); and if the trigger meets the criteria, executing an action

defined in the rule (**Croy**: page 5, par 53, L14-38, Fig. 10).

Claim 21

Croy anticipates the action further comprises sending a notification to an

administrator (**Croy**: page 3, pars 38-39; page 4, par 45, L1-4; page 5, par 53, L20-26; EN:

the display is an administrative tool, the user is an administrator).

Claim 23

Croy anticipates the metadata represents a metric associated with a business

process (**Croy**: page 1, par 5; page 4, par 44, L1-10).

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Tian US Patent Application #09/828,931

Papierniak et al US Patent #6,151,584

Shmueli et al US Patent #6,044,375

5.   Claims 1-25 are rejected.

Correspondence Information

6.   Any inquires concerning this communication or earlier communications from the

examiner should be directed to Omar F. Fernández Rivas, who may be reached

Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at

(571) 272-2589 or email omar.fernandezrivas@uspto.gov.

If you need to send an Official facsimile transmission, please send it to (571)
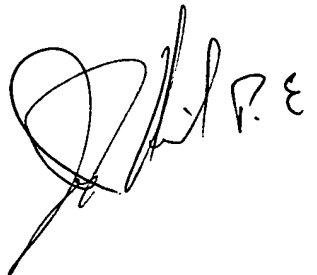
273-8300.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor,

David Vincent, may be reached at (571) 272-3080.

Hand-delivered responses should be delivered to the Receptionist @ (Customer

Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located

on the first floor of the south side of the Randolph Building.

Omar F. Fernández Rivas
Patent Examiner
Artificial Intelligence Art Unit 2129
United States Department of Commerce
Patent & Trademark Office

Friday, March 24, 2006